REMARKS

In response to the Office Action dated August 13, 2008, the Applicants have amended claims 1 and 11. Claims 1, 4, 7-9, 11, 14 and 17-19 are in the case. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1, 4, 7-9, 11, 14 and 17-19 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Laverty et al. (U.S. Patent No. 6,791,707) in view of Lahey et al. (U.S. Patent No. 6,587,217).

The Applicant respectfully traverses this rejection and contends that the Laverty et al. reference in combination with the Lahey et al. reference do not disclose, teach or suggest all of the elements of the Applicant's newly amended independent claims.

Specifically, Lahey et al. simply disclose specifying production devices of the print service provider to be used for processing the print job (see col. 7, lines 50-53 of Lahey et al.) while Laverty et al. merely disclose an on-line automated printing system that includes a front-end customer setup and product setup modules available on a web server (see Abstract and Summary of the Invention of Laverty et al.).

Although Laverty et al. disclose a Print Ready File embodying the product to be printed, clearly, Laverty et al. in combination with Lahey et al. do **not** disclose, teach or suggest features of the Applicant's **newly amended** independent claims. Namely, the combined references are missing the Applicant's claimed automatically pre-flighting the digital file at the designer location, including **automatically checking for common errors** associated during a prepress stage, automatically revising incorrect printing instructions and **automatically adding missing printing instructions** to the received document file.

Further, the combined cited references do **not** disclose, teach or suggest the Applicant's newly added automatically providing at the designer location a **remote proofing function** for a customer of the document file to be printed and automatically tracking the printing of the document file by continuously monitoring and updating a status of the document file to be printed and creating a high performance file that contains the digital file with the automatically pre-flighted and automatically proofed document file and the shipping instructions. Support for these amendments can be found throughout the specification, and in particular, in paragraphs [0026] - [0039] of the Applicant's specification as originally filed.

Also, while Laverty et al. disclose at col. 10, lines 39-45 a customer selecting and ordering a particular product through the web site and the web site loading a pre-configured order form for the selected product, **the web site then transmits the data to the system which generates the Print Ready File** (e.g., as a unique PostScript file). In other words, Laverty et al. do **not** disclose, teach or suggest the Applicant's claimed creating a press ready file at the designer location that encompasses the automatically pre-flighted and automatically proofed document file and both said print job and said job ticket.

Instead, Laverty et al. disclose that a customer "inputs data" to be printed using on a web site of the printer (see col. 10, lines 26-29 of Laverty et al.). Moreover, Laverty inputs that data in a "pre-configured order form." (see col. 10, lines 40-43 of Laverty et al.). Basically, Laverty et al. provide data to another so that they may create such a file. Hence, entering data into a web based order form is not creating a file "at the designer location", like the Applicant's claimed invention.

In addition, the Examiner is reminded that the references **should not** be considered together with the benefit of hindsight. Improper hindsight occurs when knowledge and advantages from the Applicant's disclosure is used, or words or phrases are arbitrarily picked and chosen from references to recreate the Applicant's invention. Crown Operations International, Ltd. v. Solutia, Inc., 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In particular, the combination of elements in a manner that reconstructs the Applicant's invention only with the benefit of **hindsight** is insufficient to present a prima facie case of obviousness. Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Even if the references in question seem relatively similar "...the opportunity to judge by hindsight is particularly tempting. Hence, the tests of whether to combine references need to be applied rigorously," especially when the Examiner uses a reference that does not explicitly disclose the exact elements of the invention from all of the Applicant's independent claims. McGinley v. Franklin Sports Inc., 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

Therefore, because the combined cited references are missing at least one feature of the independent claims and because hindsight cannot be used, the Applicant submits that a prima facie case of obviousness does not exist. As a result, the independent claims are patentable over the combined references. As such, withdrawal of the obviousness rejections of the claims is respectfully requested.

Further, with regard to the dependent claims, since they depend from the above-argued respective independent claims, they are therefore patentable on the same basis. (MPEP § 2143.03). As such, withdrawal of the obviousness rejection of the claims is respectfully requested.

Thus, it is respectfully requested that all of the claims be allowed based on the amendments and arguments. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. Additionally, in an effort to further the prosecution of the subject application, the Applicants kindly **requests** the Examiner to telephone the Applicant's attorney at **(818) 885-1575**. Please note that all mail correspondence should continue to be directed to:

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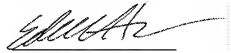

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